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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,603	08/28/2003	David H. Burkett	ACS 65356 (1747D)	8329

24201 7590 11/27/2006

FULWIDER PATTON
6060 CENTER DRIVE
10TH FLOOR
LOS ANGELES, CA 90045

EXAMINER

HONG, JOHN C

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,603

Applicant(s)

BURKETT, DAVID H.

Examiner

JOHN C. HONG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1,4-6,9,12,13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gambale et al. (U.S. Patent 5031636).**

Gambale et al. disclose : **Regarding Claims 1 and 4-6**, a process for forming a guide wire for use in a medical procedure, comprising :forming a male end (36) at an extremity of a first elongated member formed of a first continuous material; forming a female end (26) at an extremity of a second elongated member, the second elongated member and the female end being formed of a second continuous material; and permanently securing (crimping; col. 7, lines 42-44) the male end of the first elongated member within the female end of the second elongated member (Fig. 2- 4);and **Regarding Claim(s) 9,12,13 and 18**, a guide wire for use in a medical procedure, comprising: a first elongated member having an extremity and a male end (36) formed at the extremity, the first elongated member formed of a first continuous material; a second elongated member including a second extremity, the second extremity of the second elongated member including a female end (26), the second elongated member and the female end being formed of a second continuous material; wherein the male end is permanently secured (crimping; col. 7, lines 42-44) within the female end of a second elongated member (Fig. 2-4).

NOTE: Col: 7, lines 42-44 describes the guide wire **12** and extension wire **24** are **crimped** and the crimped connection maybe broken easily (col.7, lines 23-26) since the **connection is made permanently secured.**

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al. in view of Abrams et al. (U.S. Patent 5341818).**

Gambale et al. teach a process for constructing a guidewire; comprising: providing an elongated proximal core portion including a distal extremity and having a male end (36) disposed at the distal extremity, the proximal core portion being formed from a first continuous material including stainless steel, providing a distal core portion including a proximal extremity and having a female end (26) with a predetermined depth disposed at the proximal extremity, the distal core portion and female end being formed from a second continuous material ; permanently securing (crimping; col. 7, lines 42-44) the male end within the female end; and disposing the flexible body member about the distal core portion (Fig. 2-4).

Gambale et al. fail to teach the distal core portion and female end being formed from a second continuous material including a nickel-titanium alloy.

Abrams et al. teach the distal core portion and female end being formed from a second continuous material including a nickel-titanium alloy (col. 4, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilizing nickel-titanium alloy for forming the distal core portion and female end, as taught by Abrams et al. on the method of Gambale et al. so as to achieve stress-induced phase transformation.

NOTE: The rationale to modify or combine the prior art **does not have to be** expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

5. Claims 2,3,7,8,10,11,14,and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al. .

Gambale et al. teach the limitation except the steps of : forming hole by electrical discharge machine; laser drilling; plunge grinding; securing by soldering, welding, and gluing.

But the steps of : forming hole by electrical discharge machine; laser drilling; plunge grinding; securing by soldering, welding, gluing are well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the

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above well known method on the process of Gambale et al. so as to manufacture more flexible guidewire.

Response to Arguments

1. Applicant's arguments filed 9/12/06 have been fully considered but they are not persuasive. See the new Office action.

Regarding applicant's arguments :

(A) That the Gambale et al. does not teach permanently securing the male end and the female end. But Gambale et al. clearly teach the connection is crimped (col.7, lines 42-44) which is permanently secure so the connection maybe easily broken. Gambale et al. further describes in col. 7, lines 11-14, 'It has been found that a connection can be made quickly and easily. It maintains sufficient tensile strength of the order of about one or two pounds force so as not to come apart during use.'

(B) Objective reason has not been presented to modify Gambale et al. in view of Abrams et al. . Gambale et al. is not concerned with achieving "stress-induced phase transformation"

But the rationale to modify or combine the prior art **does not have to be** expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

(C) Abrams et al. does not teach the distal core portion and female end being formed from a second continuous material. But the Abrams et al. teach the utilizing superelastic material such as Ni-Ti type alloys on the portions of guiding members (col.4, lines 25-30; col. 4, lines 54-58), and this teaching is well known in the art.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN C. HONG whose telephone number is 571-272-4529. The examiner can normally be reached on HPH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID BRYANT can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JOHN C HONG
Primary Examiner
Art Unit 3726

Jh
November 18, 2006